



OFFICE OF THE ATTORNEY GENERAL OF TEXAS  
AUSTIN

GROVER SELLERS  
ATTORNEY GENERAL

Honorable Claude Isbell  
Secretary of State  
Austin, Texas

Dear Sir:

Attention: Mr. J. L. McGarity

Opinion No. 0-6845

Re: Whether the Secretary of State should accept for registration a toy design used for advertising purposes.

In your letter of September 19, 1945, you state that there was presented to you on June 8, 1945, a certain "toy design", accompanied by an application for registration as a trade-mark under the provisions of Articles 843-851, inclusive, Revised Civil Statutes, 1925. You further state that on June 14, 1945, you returned said application, refusing to file the same and expressing the opinion that such "toy design" was not subject to registration. Inasmuch as such application and "toy design" have been returned to you for filing, you request our opinion, asking the following questions:

- "1. Should the Secretary of State file the application in question in its present form?
- "2. Can the application be so amended as to make it subject to being filed?"

It is noted that the article involved in your inquiry and submitted with a photostatic copy of the owner's application for its registration is so constructed that it has as its base two narrow strips of wood material painted green. Colored figures of two men standing opposite each other in boxing attire are so fixed to the wooden strips that when the end of each strip is pulled in opposite directions, back and forth, the arms of the boxing figures, loosely fastened, fly out at each other. The name S-D-M Mfg. Co.

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appears on each side of the boxing figures. The name of a company with the words "Pat. Applied For" appears on one side and such company's apparent business "Toyland" appears on the other side of the base or wooden strips. The application refers to the article as "a toy design" and the applicant makes affidavit that such has been used by applicant since January 1, 1940.

Art. 851, R. C. S., 1925, provides:

"Every person, association or union of workmen, incorporated or unincorporated, that has heretofore or shall hereafter adopt a label, trade mark, design, device, imprint or form of advertisement, shall file the same in the office of the Secretary of State by leaving two facsimile copies, with the Secretary of State, and said Secretary shall return to such person, association or union so filing the same, one of said facsimile copies along with and attached to a duly attested certificate of the filing of same, for which he shall receive a fee of one dollar. Such certificate of filing shall in all suits and prosecutions under this chapter be sufficient proof of the adoption of such label, trade mark, design, device, imprint or form of advertisement, and of the right of such person, association or union to adopt the same. No label, trade mark, design, device, imprint or form of advertisement shall be filed as aforesaid that would probably be mistaken for a label, trade mark, design, device, imprint or form of advertisement already of record. No person, or association shall be permitted to register as a label, trade mark, design, device, imprint or form of advertisement any emblem, design or resemblance thereto that has been adopted or used by any charitable, benevolent or religious society or association, without their consent."

The term "trade mark" is defined in Corpus Juris as a name, sign, symbol or device which is attached to goods offered for sale in the market so as to distinguish them from similar goods, and to identify them with a particular trader, or with his successors, as owners of a particular business, as being made, worked on, imported, selected, certified, or sold by him or them. 63 C. J. p. 308. "Trade mark" has been defined in this State as follows:

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"A trade mark is a distinctive name, word, mark, emblem, design, symbol or device used in lawful commerce to indicate or authenticate the source from which has come or through which has passed, the chattel upon or to which it is affixed." (Weston Groc. Co. vs. Caffarelli Bros., 108 S. W. 413, reversed on other grounds, 127 S. W. 1018)

In an early case styled Charles Alff and Co. vs. William Radam, 77 Tex. 530, decided in June, 1890, the Supreme Court of Texas expressly recognized that what constitutes a "trade mark" is a question of law for the courts. It would therefore appear that with the enactment of the registration statutes, the Legislature was not attempting to afford protection to other than what could reasonably be identified and recorded as a "trade mark" by such common descriptive terms as label, design, device, imprint or form of advertising.

It is apparent from the request that your refusal of the application was based solely upon the form or make-up of the "toy design" as presented for filing with the application.

There appears to be ample authority to the effect that the substance or any useful part or feature of the article itself cannot be appropriated as a trade mark. The leading case of Goodyear Tire and Rubber Co. vs. Robertson, 18 Fed. 2d 639, and cases cited therein supports the above proposition. We quote from the Robertson case on page 641, as follows:

"But the chattel itself is not and cannot be the trademark. Moreover, while a mark otherwise good may be so fabricated with the goods as to be an integral part therewith, yet, if it forms a useful or functional part of the whole, it is not a valid trade mark and may not be registered. Otherwise the owner would secure not merely the exclusive right to use the mark, but also the exclusive right to make the article itself, and would thus secure a perpetual monopoly irrespective of patentability."

It stands to reason that if an article or chattel itself, which, as to its physical structure or make-up, cannot be a valid trade mark or appropriated as such, same would be outside the scope of the above registration statute. The very import of the act of registration, the chief concern of this statute, refutes any idea of the Secretary of State being a depository of such articles or chattels rather than a registrar, namely, one who records or an official recorder.

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Answering your first question, it is the opinion of this department that the Secretary of State is not required to accept for registration as a "trade mark" under Article 851, R. C. S., the "toy design" in the form submitted.

As to your second question, we consider same a premature one of administration, not properly before this department.

We are returning herewith the "toy design" as requested.

Yours very truly,

ATTORNEY GENERAL OF TEXAS

By

*Wm. J. R. King*  
Wm. J. R. King  
Assistant

WmK:LJ  
encl.

APPROVED OCT 25 1945  
*Wm. J. R. King*  
FIRST ASSISTANT  
ATTORNEY GENERAL

